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| EXAMINER | |
|---|---|
| VARNUM, RYAN A | |

| ART UNIT | PAPER NUMBER |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/598,292 | FRANCK ET AL. | |
| | Examiner | Art Unit | |
| | RYAN A. VARNUM | 3751 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *23 August 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *11-22* is/are pending in the application.

4a) Of the above claim(s) *1-10* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *11-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *23 August 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *8/23/2006; 10/31/2006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

1. This office action is responsive to the amendment filed on 8/23/2006. As directed by the amendment: claims 1-10 have been cancelled and claims 11-22 have been added. Thus, claims 11-22 are presently pending in this application.

### *Claim Objections*

2. Claim 16 is objected to due to the following informalities: it appears that the language of Claim 16 should be corrected to read as follows:

> "The mechanical pencil according to claim 11, wherein two diametrically opposed regions of endpiece-lead brake friction are provided, and wherein two diametrically opposed regions of lead-lead brake friction are provided, the regions of ~~lead-lead brake friction~~ endpiece-lead brake friction being angularly shifted about 90 degrees relative to the regions of lead-lead brake friction."

3. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

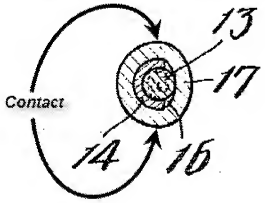
5. Claims 11-15, 17, 18 and 20-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Minagawa (US Patent 3,664,753).

6. In re Claims 11, 14, 18, 21 and 22, Minagawa discloses a mechanical pencil comprising: a body 1 (Column 2, Lines 63-64) extending longitudinally along an axis X between a forward writing end and a rear end (See Fig. 1); an endpiece 4 ("tubular tip member"; Fig.'s 1 and 3; Column 2, Line 71) situated at the forward end (See Fig. 1); a lead guide 14 (Fig.'s 1, 3 and 6; Column 3, Line 61) that can be retracted into said endpiece (See Fig.'s 2a and 3) and comprising a conduit for the passage of a lead 13 (See Fig. 6; Column 3, lines 70-73) and for its guidance in translational movement along said axis X (See Fig.'s 1, 3 and 6); and a lead brake 17 ("annular rubber member"; Fig. 6; Column 4, Line 1) made of an elastically deformable material ("rubber") connected to said lead guide (See Fig. 6), said lead brake comprising at least one region of friction between the lead and said lead brake (See Fig. 7; friction being present where brake 17 contacts lead 13) to limit the movement of the lead in said lead guide (Column 4, Lines 60-63), and at least one region of friction between said endpiece and said lead brake (See Fig. 2B; Column 4, Lines 43-49; it being understood that elastically deformable brake 17 contacting the sloping surface 4"'' of endpiece 4 will result in a frictional force being applied against brake 17) to limit the movement of said Lead guide in the endpiece, wherein each region of friction between the lead and said lead brake is shifted angularly about the axis X relative to each region of friction between said endpiece and said lead brake (it being understood that, where the contact surface between 17 and 4"'' is circular, the point of friction between the lead and the brake will

be shifted angularly to at least one point of friction between the endpiece and the brake), wherein said lead brake is positioned on said lead guide between two shoulders (See Fig. 6; Column 3, Line 73 to Column 4, Line 2; brake 17 being positioned between a top shoulder and bottom shoulder formed by the opening 16 in guide tube 14), and wherein said lead guide and the said lead brake form a one-piece component (See Fig. 6; Column 4, Lines 35-37) composed of at least two materials (Column 4, Lines 18-22).

7. In re Claims 12, 13 and 17, Minagawa further discloses said brake 17 (Fig. 6), considered perpendicularly to the axis X (as depicted in Fig. 7), includes an elongate shape (See Fig. 7), wherein regions of said endpiece-lead brake friction being formed at each end of the elongate shape ("contact"; See Annotated Fig. 7 below; it being understood that endpiece 4 being circular will contact both of these points); said lead brake includes an annular shape (See Fig. 7); and said lead brake includes a torus-shape before being fitted on said lead guide (See Fig. 7).

**Annotated Fig. 7**



8. In re Claims 15 and 20, Minagawa further discloses the conduit of said lead guide 14 (Fig. 6) comprises at least one opening 16 (Fig. 6) through which said lead brake 17 (Fig. 6) acts on the lead 13 (Fig.'s 6 and 7), in a region of lead-lead-guide friction (Column 4, Lines 60-63; See Fig 7, where brake 17 contacts lead 13); and said lead guide forms the forward end of a cartridge 6 ("reservoir"; Fig. 1; Column 3, Line 19) comprising a lead feed mechanism 9 ("retaining chuck"; Fig.'s 1-3; Column 3, Lines 36-40) and mounted removably inside said body ("threaded connection 3"; See Fig. 3; Column 2, Line 71 to Column 3, Line 3).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minagawa.

11. In re Claim 16, Minagawa discloses two diametrically opposed regions of endpiece-lead brake friction ("contact"; See Annotated Fig. 7 above; said "contact" points being locations wherein brake 17 contacts endpiece 4, such contact resulting in a friction force); and a region of lead-lead brake friction (See Fig. 7; friction occurring between the two members where brake 17 contacts lead 13), the regions of endpiece-

lead brake friction being angularly shifted about 90 degrees relative to the region of lead-lead brake friction (it being understood that, where the contact and thus friction forces between brake 17 and endpiece 4 occur over a circular region, there will necessarily be regions of endpiece-lead brake friction which are angularly shifted about 90 degrees relative to the region of lead-lead brake friction).

12. Although Minagawa does not disclose a second region of lead-lead-brake friction diametrically opposed to the first region, it is the Examiner's opinion that it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a second region of lead-lead-brake friction diametrically opposed to the first region, for the purpose of providing a greater retaining force on the lead as it moves through the guide tube, since It has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).*

13. In re Claim 19, the claimed feature of "said lead brake is overmolded" (Lines 2-3), is a product by process limitation. "[E]ven though product-by-process claims are limited by and defined by the process; determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

14. Minagawa discloses a lead guide tube 14 (Fig. 6) and the final product of the brake being formed of an elastomer ("rubber"; Column 4, Line 1). Furthermore, the product-by-process limitation of "said lead brake is overmolded" would not be expected to impart any distinctive structural characteristics to the lead brake. Therefore, the lead brake of the prior art appears to be the same as Applicant's claimed lead brake feature, thus rendering the claimed feature patentably indistinguishable over the prior art of Minagawa.

15. Although Minagawa does not disclose the lead guide being made of a synthetic resin it is the Examiner's opinion that it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the guide tube of a synthetic resin, for the purpose of choosing a construction material which is well known in the art and presents many characteristics favorable for facilitating construction while at the same time reducing construction costs, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin, 125 USPQ 416.*

***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Kageyama et al. (US Patent 4,884,910), which discloses a mechanical pencil having an endpiece, a guide tube and a lead brake structure, wherein regions of endpiece-lead brake friction are shifted angularly to regions of lead-lead brake friction.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RYAN A. VARNUM whose telephone number is (571) 270-7853. The examiner can normally be reached on Monday - Friday, 9:00 AM - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on (571) 272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. A. V./
Examiner, Art Unit 3751

/David J. Walczak/
Primary Examiner, Art Unit 3751